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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/693,433	10/24/2003	Navpreet Singh	SP-1309	2019
44388	7590	01/30/2006	EXAMINER	
SOLAE, LLC P. O. BOX 88940 ST. LOUIS, MO 63188			COE, SUSAN D	
			ART UNIT	PAPER NUMBER
			1655	
DATE MAILED: 01/30/2006				

Please find below and/or attached an Office communication concerning this application or proceeding.

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on December 8, 2005 has been entered.
2. Claims 2, 3, 8, and 17-20 have been cancelled.
3. Claims 1, 4-7 and 9-16 are currently pending.

Claim Objections

4. Claims 4 and 14 are objected to under 37 CFR 1.75(c), as being of improper dependent form for failing to further limit the subject matter of a previous claim. Applicant is required to cancel the claim(s), or amend the claim(s) to place the claim(s) in proper dependent form, or rewrite the claim(s) in independent form. Claims 4 and 14 do not properly further limit claim 1. Claim 1 is drawn to method "consisting essentially of." As discussed in MPEP section 2111.03, "The transitional phrase 'consisting essentially of' limits the scope of a claim to the specified materials or steps 'and those that do not materially affect the basic and novel characteristic(s)' of the claimed invention." Thus, adding additional method step and stating that the method "further comprises" these step improperly broadens the scope of the claims.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

5. Claims 4 and 14 rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. As discussed above, claims 4 and 14 state that the process of claim 1 “further comprises” additional method steps. These claims are confusing because claim 1 is “consisting essentially of” the claimed steps. Using “further comprises” makes the scope of the claim unclear. In addition, it is confusing to add additional method steps to a method that “consists essentially of.” Does applicant mean that these steps do not affect the basic and novel characteristics of the process?

Claim Rejections - 35 USC § 103

6. Claims 1, 4-7, and 10-16 are rejected under 35 U.S.C. 103(a) as being unpatentable over US Pat. No. 5,505,946 for the reasons set forth in the previous Office action.

All of applicant’s arguments regarding this ground of rejection have been fully considered but are not persuasive. Applicant argues that the claims are patentable because the claims have been amended to recite a process that “consists essentially of” the stated steps. US ‘946 does not appear to contain any steps that are specifically excluded by applicant. US ‘946 does show one embodiment with an ethanol extraction; however, the reference specifically teaches that this step can be excluded. In fact, the reference recommends omitting this step because a better product is obtained without the use of ethanol (see column 3, lines 3-7). Thus, a

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person of ordinary skill in the art would reasonably expect that the ethanol extraction step taught in Example 1 could be excluded from that method of extraction. In addition, as discussed in MPEP section 2111.03, "If an applicant contends that additional steps or materials in the prior art are excluded by the recitation of 'consisting essentially of,' applicant has the burden of showing that the introduction of additional steps or components would materially change the characteristics of applicant's invention."

Applicant also argues that the reference does not teach using two acetone extraction steps, agitating the acid/soybean slurry for an hour, or using all of the pH amounts claimed by applicant. However, as discussed in the Office action of October 19, 2004, US '946 does teach that two acetone extractions can be utilized in the extraction of the inhibitor (see Example 7). Thus, a person of ordinary skill in the art would reasonably expect that two acetone extractions could be used in the method of Example 1 in order to achieve a larger amount of extraction of acetone insoluble components from the soybean. Based on this reasonable expectation of success, a person of ordinary skill in the art would be motivated to add an additional acetone extraction step to the method of Example 1. Furthermore, Example 1 does not specifically teach using all of the amounts of acetone claimed by applicant. However, the subsequent examples use a variety of amount of acetone. Thus, the amount of acetone is a variable that can be optimized in order to best achieve the extraction of the acetone insoluble components from the soybean.

The reference also does not specifically teach agitating the acid/soybean slurry for an hour or using all of the acid pH's claimed by applicant. However, the pH and mixing time for an extraction procedure are clearly a result effective parameters that a person of ordinary skill in the

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art would routinely optimize. It would have been customary for an artisan of ordinary skill to determine the optimal amount of each ingredient to add in order to best achieve the desired results of creating acid extracted solubles from defatted soybean. Thus, absent some demonstration of unexpected results from the claimed parameters, this optimization of ingredient amount would have been obvious at the time of applicant's invention.

The reference does not specifically teach a Bowman-Birk inhibitor with the protein and chymotrypsin inhibitor activity claimed. However, as discussed above, the reference is considered to teach a method for making a Bowman-Birk inhibitor that meets all the limitations of applicant's claims. Thus, since the prior art teaches a method that is the same as claimed, the product resulting from this method would naturally have the same characteristics as claimed.

7. No claims are allowed.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Susan Coe whose telephone number is (571) 272-0963. The examiner can normally be reached on Monday to Thursday from 9:30 to 5:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Terry McKelvey, can be reached at (571) 272-0775. The official fax phone number for the organization where this application or proceeding is assigned is (571) 273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Any inquiry of a general nature or relating to the status of this application or proceeding can be directed to the receptionist whose telephone number is (571) 272-1600.

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Susan D. Coe

1-26-06

Susan D. Coe
Primary Examiner
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